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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,648	05/14/2001	Amy J. Donnan	DON0002/US/2	8779

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EXAMINER

SUHOL, DMITRY

ART UNIT PAPER NUMBER

3712

DATE MAILED: 05/08/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

66

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/854,648		DONNAN, AMY J.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Dmitry Suhol		3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 February 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4 and 6-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4 and 6-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 6, the structural features encompassed by the phrase “tear drop-shaped” can’t be determined, rendering the claim indefinite.

Regarding claim 7, the structural features encompassed by the phrase “sun-shaped” can’t be determined.

Regarding claim 8, the structural features encompassed by the phrase “fire-shaped” can’t be determined, rendering the claim indefinite.

Regarding claim 9, the structural features encompassed by the phrase “ghost-shaped” can’t be determined, rendering the claim indefinite.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 6-9 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaver. Shaver discloses an interactive toy containing all the elements of the claims including, providing a plurality of play-pieces as required by claims 1 and 13 (figs. 9a-9i), a container comprising a storage chamber as required by claims 1 and 13 (fig. 1), each play-piece comprising a unique color, as required by claims 1 and 13, (figures 9a-9i) where the figures clearly show that each play-piece comprises only one color, a unique visually discernible facial expression comprising eyes and a mouth, as required by claims 1 and 13, (figs. 9a-9i) where the figures clearly show that each play-piece comprises only one facial expression, a first play piece corresponding to love (9c), a second play piece corresponding to sad (9g), a third play piece corresponding to happiness (9a), a fourth play piece corresponding to mad (9h), and a fifth play piece corresponding to being scared (9f) as required by claim 4. Regarding claims 6-9 it is considered that the shape of the play-pieces in figures 9a-9i reads on all the shapes as best understood in claims 6-9. The container being a plush, pillow bag as required by claim 12 is described in col. 3, lines 36-43. Interacting with the toy to explore emotional experience, as required by claims 13 and 14, is described in col. 4, lines 25-57 and col. 5, lines 28-37. Regarding claim 15 it is inherent that the play piece would be withdrawn from the container, especially since the container opens as shown in figure 5 and described in col. 4, lines 21-24. Naming the emotion corresponding to a play piece, as required by claim 16, is described in col. 5, lines 28-37.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 13 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Childsworld/Childsplay "Feelings Frogs Game". Childsworld/Childsplay discloses interactive play-pieces including most of the elements of the claims, with reference to claims 1 and 13, providing a plurality of play-pieces (see Childsworld/Childsplay "Feelings Frogs Game", page 22), each play-piece comprising a unique color (see Childsworld/Childsplay "Feelings Frogs Game", page 22) where the figures clearly show that each play-piece comprises only one color and textual information indicative of an emotion (as required by claims 17 and 18 (see Childsworld/Childsplay "Feelings Frogs Game", page 22). Interacting with the toy, as required by claim 13, to explore an emotional experience is inherent with the toy and pointed to in the description on page 22.

Although Childsworld/Childsplay discloses most of the elements of the claims, as stated above, the reference fails to teach a unique visually discernible facial expression comprising eyes and a mouth, as required by claims 1 and 13, a container comprising a storage chamber as required by claims 1 and 13 (fig. 1). However, the use of facial expressions, comprising eyes and mouth, on toys to facilitate exploration of emotions is well known in the art (i.e. Solomon U.S. Patent 4,341,521 and others). Therefore it

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would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to provide facial expressions of the frogs of Childsworld/Childsplay for the purpose of further displaying/identifying a distinctive emotion associated with the toy. Providing a container would have been obvious since toys are generally sold and packaged in a container for the purpose of ease of storage.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaver et al '778 in view of Solomon '521. Shaver discloses all the elements of the claims, as stated above, but for each play-piece comprising one or more panels enclosing stuffing material, however Solomon teaches a psychotherapeutic toy, like that of Shaver, which teaches a play-pieces comprising panels enclosing stuffing material (figure 2, element 26 and col. 2, lines 48-50). Therefore it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to manufacture the toy of Shaver with play-pieces comprising panels enclosing stuffing material for the purpose of providing a pleasing tactile aspect for the user.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shaver et al '778. Shaver discloses all the elements of the claims, as stated above, but for a container being heart-shaped as required by claim 11, however it would have been obvious to manufacture the toy of Shaver with a container being heart shaped for the purpose of representing an emotion of love by the container, especially since such construction is well known in the art (i.e. U.S. Patent 4,917,607 element 45).

Furthermore the shape of the container is considered to be an obvious choice of design in that applicant discloses no advantage or critical need for such a shape (see applicants specification page 6, lines 21-22).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 4, 6-18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ds  
May 5, 2003

  
DERRIS H. BANKS  
PATENT EXAMINER  
TECHNOLOGY CENTER 3700